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**AUG 15 2003**

**OFFICE OF PETITIONS**

In re Application of  
Mark D. Scott and John W. Eaton  
Application No. 09/323,765

Filed: June 1, 1999

Attorney Docket No.: 259.006US1

Title: ANTIGENIC MODULATION OF  
CELLS

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR §1.137(a)<sup>1</sup> to revive the above-identified application, as well as a petition to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181(a)<sup>2</sup>, and the petition to revive the application under 37 C.F.R. §1.137(b)<sup>3</sup>, each filed together on July 28, 2003.

1 A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

2 Although this section of the C.F.R. was not listed in the heading of the petition, the text of the petition does request that the abandonment of the application be withdrawn.

3 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

On March 25, 2002, an Appeal Brief was filed by the applicant. On August 29, 2002, the Office mailed a Notification of Non-Compliance with 37 C.F.R. §1.192(c) (Notification), stating that the Appeal Brief was defective. The Notification set a one-month period for response. On September 30, 2002, a supplemental brief was received<sup>4</sup>. On January 24, 2003, the Office mailed a communication stating that this supplemental brief was defective as well. As the supplemental brief was defective, the appeal was properly dismissed, pursuant to 37 C.F.R. §1.192(d). Accordingly, the above-identified application became abandoned on September 30, 2002, and the communication mailed on January 24, 2003 further served as a Notice of Abandonment.

On July 28, 2003, petitioner filed instant petitions, along with a second supplemental brief.

The petition under 37 C.F.R. §1.181(a)

On page 5 of his petition, Petitioner states that the petition to withdraw the holding of abandonment should be granted under 37 C.F.R. §1.27(a). It is noted that this section of the C.F.R. pertains to small entity status, and is not related to petitions to withdraw the holding of abandonment. The portions of the C.F.R. and MPEP cited immediately below are controlling.

The petition to withdraw the holding of abandonment is dismissed as untimely. The petition was filed on July 28, 2003. MPEP 711.03(c) sets forth that a petition to withdraw the holding of abandonment must be filed within two months of the mail date of the notice of abandonment (January 24, 2003)<sup>5</sup>.

As such, the petition under 37 C.F.R. §1.181(a) is **DISMISSED**.

The petition under 37 C.F.R. §1.137(a)

Concerning the petition under 37 C.F.R. §1.137(a), the petition lacks item (3) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.**

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”<sup>6</sup>

<sup>4</sup> The Supplemental Brief contained a certificate of mailing dated September 23, 2002.

<sup>5</sup> See also 37 C.F.R. 1.181(f).

<sup>6</sup> *Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’s interpretation of a statute it administers is entitled to deference”); see also *Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”))

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked any basis in reason or common sense.”<sup>7</sup>

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”<sup>8</sup>

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”<sup>9</sup>

### The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”<sup>10</sup>

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”<sup>11</sup>

Nonawareness of a PTO rule will not constitute unavoidable delay<sup>12</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application<sup>13</sup>.

A delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered “unavoidable”

<sup>7</sup> Commissariat A L’Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

<sup>8</sup> Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

<sup>9</sup> Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

<sup>10</sup> Id.

<sup>11</sup> See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>12</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

<sup>13</sup> Id.

due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action<sup>14</sup>.

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions<sup>15</sup>. Specifically, petitioner's delay caused by the mistakes of negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133<sup>16</sup>.

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney"<sup>17</sup>.

"Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions"<sup>18</sup>.

### **The portion of the Code of Federal Regulations relevant to the abandonment of this application**

37 CFR 1.192. Appellant's brief.

- (a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.
- (b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.
- (c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:
  - (1) Real party in interest. A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.
  - (2) Related appeals and interferences. A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.
  - (3) Status of claims. A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.

<sup>14</sup> See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>15</sup> *Link v. Wabash*, 370 U.S. 626, 633-634 (1962).

<sup>16</sup> *Haines*, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

<sup>17</sup> *Link* at 633-634.

<sup>18</sup> *Inryco, Inc. v. Metropolitan Engineering Co., Inc.*, 708 F.2d 1225, 1233 (7th Cir. 1983). See also, *Wei v. State of Hawaii*, 763 F.2d 370, 372 (9th Cir. 1985); *LeBlanc v. I.N.S.*, 715 F.2d 685, 694 (1st Cir. 1983).

- (4) Status of amendments . A statement of the status of any amendment filed subsequent to final rejection.
- (5) Summary of invention. A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.
- (6) Issues. A concise statement of the issues presented for review.
- (7) Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.
- (8) Argument. The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.
  - (i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,
    - (A) Describe the subject matter defined by each of the rejected claims,
    - (B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and
    - (C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.
  - (ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - (iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.
  - (iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.
  - (v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.
- (9) Appendix. An appendix containing a copy of the claims involved in the appeal.
- (d) *If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed (emphasis added).*

#### **Application of the standard to the current facts and circumstances**

In the petition, petitioner maintains that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a).

In support thereof, petitioner fails to submit an argument as to why the abandonment was unavoidable. All petitioner submits is that he considers the errors to be minor, and he feels that he should have been given a chance to correct the deficiencies in the brief.

Petitioner is directed to 37 C.F.R. §1.192(d), reproduced above, which sets forth the applicable procedure for the instant situation. When a brief is determined to be defective, applicants are

informed of such, and provided with a one-month period of time to file an amended brief. If the amended brief is determined to be defective, the appeal will be dismissed.

On March 25, 2002, an Appeal Brief was filed by the applicant. On August 29, 2002, the Office mailed a Notification, informing that the brief was defective. Applicant was given one-month to submit an amended brief. On September 30, 2002, an amended brief was submitted. As the amended brief was deemed to be defective, the appeal was properly dismissed.

It appears that the Office properly adhered to the procedure set forth in 37 C.F.R. §1.192(d), allowing the applicant the opportunity to correct his defective brief. When he was not able to submit an acceptable brief after two opportunities, the application became abandoned as an operation of law.

For this reason, the showing in the petition is not sufficient to constitute unavoidable delay, and the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

The petition under 37 C.F.R. §1.137(b)

37 C.F.R. §1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.137(b)(3) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

With the instant petition, the petitioner has met the requirements to revive the above-identified application, pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of the filing of a Second Supplemental Appeal Brief, the payment of the associated fee (which has been charged to his Deposit Account, as authorized in the petition), and has made a statement which is being construed as the proper statement of unintentional delay.

The Second Supplemental Appeal Brief filed on July 28, 2003 with the current petitions has been entered and made of record.

The application file is being forwarded to Technology Center 1600 for processing of the Second Supplemental Appeal Brief.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0011.



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